

### REMARKS

This is in response to the Office Action mailed on March 21, 2006, in which claims 1, 5-10 and 12-29 were rejected. Claims 1, 5-7, 12, 16-17 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh et al. (U.S. Patent Application 2002/0112395 A1). Claims 10 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh as applied to claim 1 and further in view of Grueling (U.S. Patent Number 2,264,875). Claims 8, 9, 13-14 and 18-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh as applied to claim 1 and further in view of Nelson (U.S. Patent Number 6,185,862). Claims 24-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh in view of Nelson.

### Interview with Examiner Rowan

A phone interview between Examiner Kurt Rowan and David Fairbairn took place on June 7, 2006. The interview included a discussion of the references cited in the Office Action mailed on March 21, 2006, specifically Marsh and Nelson, as well as a discussion of claims 1 and 25. Although an agreement was not reached as a result of this interview, the Applicant acknowledges that the interview was helpful in exploring the presentation of the claims pending in this Application.

### Claim Rejections under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaches; (2) there must be a reasonable expectation of success; and (3) the prior art reference, or references when combined, must teach or suggest all the claim limitations. (See M.P.E.P. § 2143.)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh. With this amendment, claim 1 requires a main body formed of foam and having a substantially

uniform thickness, and a release tab extending from a circumference of the main body for peeling the main body off the surface.

Marsh does not disclose a main body having a substantially uniform thickness, as required by amended claim 1. Instead, Marsh discloses that “[t]he greater thickness of the foam at the outer portions of the backing (14, 16) than the portion along the central folding axis (12) facilitates firm gripping of the insect by increasing the portion of the adhesive side of the backing that contacts the insect.” (Marsh at p. 1, ¶ 14.) Thus, Marsh teaches away from a pest removal device having a main body of substantially uniform thickness.

Moreover, Marsh does not disclose a single release tab extending from the circumference of the main body. In Marsh, tab (6) is located in the center of backing (2), as shown in FIGS. 1, 3 and 4. In addition, the tab of the Marsh device is not used to peel the main body off of the surface. Marsh discloses that “[t]he tab (6) and the portions of the folded backing nearest the tab are then grasped by the user and the device is pulled away from the skin.” (Marsh at p. 1, ¶ 14.) As shown in FIGS. 3 and 4, the Marsh device operates like tweezers to grasp or pinch the pest and pull the pest from the skin.

Amended claim 1 requires that the single release tab is “graspable to apply a pulling force to the main body and peel the main body off of the surface starting with a portion of the main body closest to the single release tab and finishing with a portion of the main body opposite the single release tab.” Thus, the single release tab is configured to lift or peel the main body off of the surface starting at a side of the main body closest to the single release tab. This claim limitation is not taught or suggested by Marsh.

Because Marsh does not teach or suggest all of the claim limitations required by claim 1, claim 1 is patentable over Marsh.

Claims 5-7 depend from claim 1 and are allowable therewith, since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. § 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claim 12 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh. With this amendment, claim 12 requires a pest removal device having a main body that is generally circular and formed of a flexible resilient foam material, wherein the main body is substantially flat having a substantially uniform thickness. As stated above in reference to claim 1, Marsh does not teach or suggest a pest removal device having a main body of substantially uniform thickness. Moreover, Marsh does not teach or suggest a main body that is generally circular. If the generally rectangular backing (2) of the Marsh device, as shown in FIGS. 1-4, were substituted with a generally circular backing, the Marsh device would not be configured for "grasping and pulling the tick away from the point of attachment." (Marsh at p. 1, ¶ 14.)

Because Marsh does not teach or suggest this claim limitation of a generally circular main body, as well as a main body having a substantially uniform thickness, claim 12 is patentable over Marsh.

Amended claim 12 also requires a release tab extending from a circumference of the main body, wherein the release tab is generally semi-circular and graspable to apply a pulling force to the circumference of the main body and peel the main body off the surface. The same arguments from claim 1 above regarding the single release tab apply to claim 12. Moreover, claim 12 requires that the release tab is generally semi-circular which is not taught or suggested by Marsh.

Claim 12 is patentable over Marsh for the reasons outlined above.

Claims 16 and 17 depend from claim 12 and are allowable therewith.

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh. Claim 23 includes means plus function elements.

The application of a prior art reference to a means plus function limitation requires that the prior art element perform the identical function specified in the claim. (See M.P.E.P. § 2182.) In addition, the prior art structure must be the same as or equivalent to the structure disclosed in the specification, which has been identified as corresponding to the claimed means plus function. (See id.)

As amended, claim 23 requires means for securing the pest to the first side of the substrate by adhering the substrate to the body surface so that the substrate covers and conforms to the body surface and the pest to completely surround and enclose the pest. Marsh does not perform this function of conforming to the body surface to completely surround and enclose the pest. Rather, as shown in FIGS. 3 and 4, the Marsh device is placed above the pest and used like tweezers to grasp and pull the pest away from the point of attachment. In addition, claim 23 also requires means for causing the pest to release itself from the surface. Marsh does not perform this function of causing the pest to release itself from the surface, but rather Marsh discloses a device for pulling the tick from the surface.

The Marsh device does not perform either of the functions outlined above from claim 23. Moreover, for both of these means plus function elements, the Marsh device does not disclose the same or an equivalent structure compared to the structure disclosed in the present application and shown in FIG. 1. As such, claim 23 is patentable over Marsh.

Claims 10 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh as applied to claim 1 and further in view of Grueling. Claims 10 and 15 depend respectively from claims 1 and 12, and are allowable therewith.

Claims 8, 9, 13-14 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh as applied to claim 1 and further in view of Nelson. Claims 8 and 9 depend from claim 1 and are allowable therewith. Claims 13, 14 and 18 depend from claim 12 and are allowable therewith.

Claim 19 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh as applied to claim 1 and further in view of Nelson. With this amendment, claim 19 requires a pest removal device having a generally circular substrate formed from a compressible foam and having a first side, a second side, and a diameter of approximately 1 inch. Claim 19 further requires

a single release tab portion extending from an edge of an engagement portion of the substrate and having a radius of approximately 0.125 inches.

Neither Marsh nor Nelson discloses a pest removal device comprising a generally circular substrate having a diameter of approximately 1 inch and a single release tab portion having a radius of approximately 0.125 inches. Moreover, neither Marsh nor Nelson disclose a device having a substrate formed from compressible foam and covered with an adhesive layer, wherein the adhesive layer and the substrate have a combined thickness that is substantially uniform, as required by amended claim 19.

As also required by claim 19, the substrate of the device is configured to be applied to and conform to the body surface to cover and smother the pest. Nelson discloses "a device for capturing insects or other small pests" (col. 1, ll. 8-9) and teaches "to avoid a strong bond between the surface and the adhesive" (col. 3, l. 67 - col. 4, l. 1). Thus, Nelson teaches away from the limitation in claim 19 that the device is configured to be applied to and conform to the body surface of an animal or a human.

Because Marsh and Nelson fail to teach or suggest all the limitations of claim 19, claim 19 is patentable over Marsh in view of Nelson.

Claims 20-22 depend from claim 19 and are allowable therewith.

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh in view of Nelson. Claim 25 is a method of use claim.

As amended, claim 25 requires providing a pest removal device formed from a flexible, resilient foam material and having a substantially uniform thickness. As discussed above in reference to claims 1, 12 and 19, Marsh does not teach or suggest a device having a uniform thickness.

Moreover, it is improper to combine the Marsh device with the Nelson device since the two devices are configured to remove a pest using different methods. Nelson uses a flat,

adhesive surface for the pest, but not the body surface, to adhere to, and Marsh operates like tweezers by grasping and pulling the pest out from the body surface.

Neither Marsh nor Nelson, alone or in combination, teach or suggest a method for securing the pest removal device to the pest *and the body surface to completely surround and enclose the pest* for a time sufficient to cause the pest to release itself from the surface, as required by amended claim 25 (*emphasis added*). Marsh does not disclose securing the pest removal device to the body surface, but instead discloses a method of "grasping and pulling the tick away from the point of attachment" (p. 1, ¶ 14) in order to remove the pest. As stated above in reference to claim 19, Nelson teaches away from securing the device to the body surface, and instead, Nelson teaches to secure the device to the pest only. (See col. 3, l. 66 - col. 4, l. 5.)

Because Marsh and Nelson fail to teach or suggest all the limitations of claim 25, claim 25 is patentable over Marsh in view of Nelson.

Claims 26-29 depend from claim 25 and are allowable therewith.

### **New Claims**

With this amendment, claims 30-33 are added. Claims 30-33 are all method of use claims and recite features of the present invention that are distinguishable over the prior art references cited above. As such, claims 30-33 are allowable.

**CONCLUSION**

Because the prior art of record does not teach, show or suggest all the claim limitations of claims 1, 5-10, 12-23 and 25-33, these claims are now in condition for allowance. Notice to that effect is respectfully requested.

The Commissioner is authorized to charge any additional fees associated with this paper or credit any overpayment to Deposit Account 11-0982.

Any inquiries regarding this application should be directed to David R. Fairbairn at (612) 339-1863.

Respectfully submitted,

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